

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Lin Zhi *et al.*

Art Unit : 1623

Serial No. : 10/080,503

Examiner : Lawrence E. Crane, Ph.D.

Conf. No. : 8671

Customer No.: 20985

Filed : February 22, 2002

Title : **TRICYCLIC QUINOLINONE AND TRICYCLIC QUINOLINE ANDROGEN
RECEPTOR MODULATOR COMPOUNDS AND METHODS**

Mail Stop-Petition

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

**PETITION UNDER 37 C.F.R. §1.47 FOR FILING AN APPLICATION
FOR PATENT WHEN A JOINT INVENTOR CANNOT BE REACHED**

Dear Sir:

This is a Petition to accept a substitute Declaration For Patent Application (hereinafter "DECLARATION") pursuant to 37 C.F.R. §1.47(a), when an inventor refuses to sign or cannot be located or reached. The above-identified application lists eleven joint inventors. All eleven joint inventors executed a DECLARATION in connection with the filing of this application. The original DECLARATION, date-stamped by the Office on May 15, 2002, is attached as Exhibit A. On the original DECLARATION, Inventor Thomas R. Caferro ("Caferro") lined through the address on the printed DECLARATION and printed his then-current address, but inadvertently did not initial and date the changes on the DECLARATION. This was brought to Applicant's attention in the Notice of Allowance. A substitute DECLARATION is required to correct this defect.

This Petition is filed in connection with the payment of the Issue Fee in response to a Notice of Allowance. Accompanying this Petition are:

- (1) a copy of the originally executed and filed DECLARATION (EXHIBIT A);
- (2) a copy of the Notice of Allowance, mailed August 31, 2006 (EXHIBIT B);
- (3) a copy of the executed substitute DECLARATION from the other inventors in this application: Robert I. Higuchi, Lin Zhi, Donald S. Karanewsky, Neelakandha S. Mani, Jyun-Hung Chen and Mark E. Adams (EXHIBIT C);
- (4) a STATEMENT OF FACTS by Frank J. Miskiel, an associate of the undersigned attorney involved with prosecuting this application, with accompanying Exhibits (EXHIBIT C);
- (5) a STATEMENT OF FACTS by Teresa Salazar-Fischer, a U.S. paralegal employed with the undersigned, with accompanying Exhibits (EXHIBIT E);
- (6) a check in the amount of \$200 for the requisite fee under 37 C.F.R. §1.17(g) for submitting this Petition; and
- (7) a return postcard.

Adjustment date: 03/21/2007 AKELLEY
12/05/2006 SDENB01 00000043 10080503
01 FC:1463 -200.00 OP
03/21/2007 AKELLEY 00000028 061050 10080503
01 FC:1462 200.00 DA 200.00 OP

CERTIFICATE OF MAILING BY "EXPRESS MAIL"
"Express Mail" Mailing Label Number **EV 740126520 US**
Date of Deposit: November 30, 2006

I hereby certify that this paper is being deposited with the United States Postal "Express Mail Post Office to Addressee" Service under 37 CFR §1.10 on the date indicated above and is addressed to: Mail Stop Petition, Commissioner for Patents, U.S. Patent and Trademark Office, P.O. Box 1450, Alexandria, VA, 22313-1450.

Frank J. Miskiel

Frank J. Miskiel

BEST AVAILABLE COPY

COPY

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Attorney's Docket No.: 18202-018001 / 1082
PETITION under 37 C.F.R. §1.47

REMARKS

A check in the amount of \$200 for the requisite fee under 37 C.F.R. §1.17(g) for submitting this Petition for filing a substitute DECLARATION for an application for patent by other than all the inventors accompanies this Petition. The Commissioner is authorized to charge any fees that may be due in connection with this paper or with this application to Deposit Account No. 06-1050. If a Petition for extension of time is required, this paper is to be considered such Petition.

Applicant hereby petitions pursuant to 37 C.F.R. §1.47(a) for acceptance of the substitute DECLARATION of the above-captioned application by other than all the inventors. The executed substitute DECLARATION is submitted under separate cover in connection with payment of the issue fee, responsive to the Notice of Allowance, mailed August 31, 2006. A copy of the executed substitute DECLARATION is attached hereto.

Under 37 C.F.R. §1.47(a), if a joint inventor refuses to join in an application for patent or cannot be found or reached after diligent effort, the application may be made by the other inventor[s]. The above-captioned application names as inventors, Robert I. Higuchi, Lin Zhi, Donald S. Karanewsky, Anthony W. Thompson, Thomas R. Caferro, Neelakandha S. Mani, Jyun-Hung Chen, Marquis L. Cummings, James P. Edwards, Mark E. Adams and Charlotte L.F. Deckhut. While diligent attempts have been made to obtain the signatures on the substitute DECLARATION of all of the joint inventors, despite diligent and repeated efforts, it has not been possible to locate and/or obtain the signatures of all of the inventors. Six of the eleven joint inventors have executed the substitute DECLARATION. Of the five joint inventors who have not executed the substitute DECLARATION, Marquis L. Cummings ("Cummings"), James P. Edwards ("Edwards"), and Charlotte L.F. Deckhut ("Deckhut") have not responded to requests to sign the DECLARATION, and Thomas Caferro ("Caferro") and Anthony W. Thompson ("Thompson") could not be located. Also, provided as part of this Petition are a Statement of Frank J. Miskiel and a Statement of Teresa Salazar-Fischer documenting the efforts to obtain all of the signatures.

As described and documented in the attached Statements and Exhibits, diligent efforts were made to locate and/or contact inventors Cummings, Edwards, Caferro, Thompson and Deckhut. Despite these efforts, neither the undersigned nor the Assignee has been able to locate and/or contact joint inventors Cummings, Edwards, Caferro and Thompson. Therefore, inventors Cummings, Edwards, Caferro and Thompson cannot be found or reached after diligent effort. Although inventor Deckhut was contacted and inventor Deckhut indicated that

COPY

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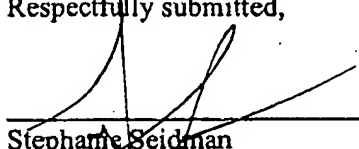
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she would execute and return the substitute DECLARATION, she has not done so. Based on the conduct of inventor Deckhut, we have concluded that inventor Deckhut refuses to sign the substitute DECLARATION.

Accordingly, in light of these efforts, and provision of the executed substitute DECLARATION of the other joint inventors (see EXHIBIT C), the fee set forth in 37 C.F.R. §1.17(g), and the last known address of each of the non-signing inventors Cummings, Edwards, Caferro, Thompson and Deckhut, favorable review of this Petition and Exhibits, and acceptance of the substitute DECLARATION in the above-captioned application without signature of joint inventors/applicants Cummings, Edwards, Caferro, Thompson and Deckhut, are respectfully requested.

* * *

Respectfully submitted,



Stephanie Seidman
Reg. No. 33,779

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